

REMARKS

The indication of allowable subject matter in claims 8-9 is acknowledged and appreciated. Accordingly, claim 8 has been rewritten into independent form, and in view of the following remarks, it is respectfully submitted that all claims are in condition for allowance. Moreover, as is self-evident, it is respectfully submitted that the enclosed amendment does not raise any new issues that would require further consideration and/or search. Accordingly, it is respectfully requested that the enclosed amendment be entered as a matter of right, which amendment is submitted to place the application in immediate condition for allowance or in better form for appeal.

Claim 5 is the sole rejected independent claim and stands rejected under 35 U.S.C. § 102 as being anticipated by Maruyama '684 ("Maruyama"). This rejection is respectfully traversed for the following reasons.

Claim 5 recites in pertinent part, "the first electrode portion and the second electrode portion *electrically connected to each other* and an interlayer insulating film formed on the plurality of internal circuits, the first I/O cell and the second I/O cell and *exposing the first electrode portion as a probing pad, the second electrode portion as a first terminal pad and the third electrode portion as a second terminal pad*" (emphasis added).

In order to read on the claimed arrangement of the first and second electrode portions, the Examiner relies on element 16 of Maruyama as the "first electrode portion" and element 14 allegedly formed on element 13A as the "second electrode portion" (see pages 3-4 of outstanding Office Action). However, it is respectfully submitted that the alleged first electrode portion 16

and second electrode portion 13A/14 of Maruyama are NOT electrically connected to each other as recited in claim 5.

Specifically, contrary to the Examiner's reliance, the external connection terminals 14 are NOT provided on the terminals 13A but instead are formed on the terminals 13B. Indeed, Maruyama expressly states that "the external connection terminals 14 are directly provided on the non-test chip terminals 13B and are not provided on the test chip terminals 13A" (emphasis added; *see* col. 7, lines 32-35 of Maruyama). Accordingly, as shown in Figures 1-2 and described in the corresponding description, the alleged second electrode portions 14 are NOT electrically connected via trace 15 to the alleged first electrode portions 16 (col. 7, lines 46-52). It is noted that terminals 13A are disclosed as being connected to test terminals 16 while terminals 13B, on which the *external* terminals 14 are located, are expressly disclosed as NOT being connected to test terminals 16.

Moreover, there are no disclosed electrode portions formed on the test terminals 13A *which are exposed* via the alleged interlayer insulating film 17, and the terminals 13A electrically connected to the alleged first electrode portions 16 are NOT exposed. In view of the foregoing, it is respectfully submitted that Maruyama does not disclose or suggest the claimed *combination* of features recited in claim 5. As anticipation under 35 U.S.C. § 102 requires that each and every element of the claim be disclosed, either expressly or inherently (noting that "inherency may not be established by probabilities or possibilities", *Scaltech Inc. v. Retec/Tetra*, 178 F.3d 1378 (Fed. Cir. 1999)), in a single prior art reference, *Akzo N.V. v. U.S. Int'l Trade Commission*, 808 F.2d 1471 (Fed. Cir. 1986), based on the foregoing, it is submitted that Maruyama does not anticipate claim 5, nor any claim dependent thereon.

The Examiner is directed to MPEP § 2143.03 under the section entitled "All Claim Limitations Must Be Taught or Suggested", which sets forth the applicable standard for establishing obviousness under § 103:

To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. (citing *In re Royka*, 180 USPQ 580 (CCPA 1974)).

In the instant case, the pending rejection does not "establish *prima facie* obviousness of [the] claimed invention" as recited in claim 6 because the cited prior art fails the "all the claim limitations" standard required under § 103.

Under Federal Circuit guidelines, a dependent claim is nonobvious if the independent claim upon which it depends is allowable because all the limitations of the independent claim are contained in the dependent claims, *Hartness International Inc. v. Simplimatic Engineering Co.*, 819 F.2d at 1100, 1108 (Fed. Cir. 1987). Accordingly, as claim 5 is patentable for the reasons set forth above, it is respectfully submitted that all claims dependent thereon are also patentable. In addition, it is respectfully submitted that the dependent claims are patentable based on their own merits by adding novel and non-obvious features to the combination.

Based on the foregoing, it is respectfully submitted that all pending claims are patentable over the cited prior art. Accordingly, it is respectfully requested that the rejections under 35 U.S.C. § 102/103 be withdrawn.

CONCLUSION

Having fully responded to all matters raised in the Office Action, Applicants submit that all claims are in condition for allowance, an indication for which is respectfully solicited. If there are any outstanding issues that might be resolved by an interview or an Examiner's

Application No.: 10/809,796

amendment, the Examiner is requested to call Applicants' attorney at the telephone number shown below.

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 500417 and please credit any excess fees to such deposit account.

Respectfully submitted,

McDERMOTT WILL & EMERY LLP



Ramyar M. Farid

Registration No. 46,692

600 13th Street, N.W.
Washington, DC 20005-3096
Phone: 202.756.8000 RMF:men
Facsimile: 202.756.8087
Date: December 14, 2005

**Please recognize our Customer No. 20277
as our correspondence address.**